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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,324	10/07/2003	Chi Florence Lao	1857.2110000	2673
26111 7590 07/18/2008 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
WHITESSELL GORDON, STEVEN H				
ART UNIT		PAPER NUMBER		
2851				
MAIL DATE		DELIVERY MODE		
07/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/679,324

Applicant(s)

LUO ET AL.

Examiner

Steven Hunt Whitesell-Gordon

Art Unit

2851

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election Requirement

1. This Office Action includes a Requirement electing among Species. The Office will issue a non-Responsive communication to a reply not completely responding to this Requirement. **An incomplete reply will not stop the running of the shortened Statutory Period set for this Office Action.** See 37 CFR § 1.111(b).
2. Election of one of the following patentably distinct Species is required under 35 U.S.C. § 121:

Species A: An embodiment described in [0050]-[0053] (Non-contacting type flow barriers, as described with respect to FIGs. 4A and 4B). The mutually exclusive characteristics for Species A are described in [0050]. Specifically, the type of the flow barrier is identified by comparison with mutually exclusive characteristics for the other Species specified below.

Species B: An embodiment described in [0054]-[0057] (Contacting type flow barriers, as described with respect to FIGs. 5 and 6) The mutually exclusive characteristics for Species B are described in lines of [0054]. Specifically, in Species B the flow barrier is a contacting type flow barrier. The other features of species B are those for Species A.

Species C: An embodiment described in [0058]. The mutually exclusive characteristics for Species C are described in lines of [0054]. Specifically, in Species C the flow barrier is a combination of non-contacting and contacting type flow barriers. The other features of species C are those for Species B.

Claim 1 and 13 are generic to the following disclosed patentably distinct species: A, B and C. The species are independent or distinct because as disclosed the different species have mutually exclusive characteristics for each identified species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Applicant must elect one, and only one, of: A, B and C.

For an Election Requirement between Species to be proper, Examiner must show: (1) the inventions are distinct, and (2) a serious burden on Examiner if restriction is not required. See, M.P.E.P. § 803I. See also M.P.E.P. § 808, stating that a proper restriction requirement must satisfy both prongs.

The above-identified Species and sub-Species are patentably distinct because they have mutually exclusive characteristics. In addition, these Species and sub-Species are not obvious variants of each other based on the current record. The first prong of the test therefore is satisfied.

Additionally, searching for and examining these distinct Species together causes serious burden. In the instant case, searching for the mutually exclusive characteristics of the Species requires different fields of search (including searching different classes/subclasses and electronic resources, and or employing different search queries). And the prior art applicable to one Species would not likely be applicable to other Species. See, for example, M.P.E.P. § 808.02(C). Furthermore, the Species are

likely to raise different non-prior art issues under 35 U.S.C. § 101 or 35 U.S.C. § 112, first paragraph, or both. The second prong of the test therefore is also satisfied.

Accordingly, requiring election between the different Species is proper.

A complete reply to this requirement must:

- 1. elect an invention to be examined even though the requirement may be traversed (37 CFR § 1.143); and**
- 2. list all claims reading on the elected invention, including any claims subsequently added.**

An argument that all claims are allowable, or that the requirement is in error, is nonresponsive unless accompanied by an election. See, for example, M.P.E.P § 818.03(b).

To preserve a right to petition under 37 CFR § 1.144, Applicant must elect with traverse. See, for example, M.P.E.P. § 818.03(c). An untimely traversal loses the right to petition under 37 CFR § 1.144. A traversal must be presented at the time of election to be considered timely.

If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. See, for example, M.P.E.P § 818.03(a).

Should Applicant traverse on the ground that the Species or sub-Species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing them to be obvious variants or clearly admit on the record that this is the case. In either instance, if Examiner finds one of the Species or sub-Species

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other Species or sub-Species.

If claims are added after the election, Applicant must indicate which of these claims are readable on the elected invention. See M.P.E.P. § 809.02(a).

Upon the cancellation of claims to a non-elected invention, Applicant must amend the inventorship complying with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Amending inventorship must be accompanied by a request under 37 CFR § 1.48(b) and include the fee required under 37 CFR § 1.17(i).

Upon the allowance of a generic claim, Applicant will be entitled to consideration of pending claims to additional Species which depend from, or otherwise require all the limitations of, an allowable generic claim as provided by 37 CFR § 1.141.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Hunt Whitesell-Gordon whose telephone number is (571)270-3942. The examiner can normally be reached on Monday to Thursday, 9:00 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diane Lee can be reached on 571-272-2399. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2851

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/SHW/
7/15/2008

/Diane I Lee/
Supervisory Patent Examiner, Art Unit 2851